

REMARKS

The Official Action mailed January 18, 2007, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on March 18, 2004 and October 15, 2004.

Claims 14-27 were pending in the present application prior to the above amendment. New claims 28-35 have been added to recite additional protection to which the Applicant is entitled. Claims 14, 15, and 18-25 have been withdrawn from consideration by the Examiner. Accordingly, claims 16, 17, and 26-35 are currently elected, of which claims 16, 28, and 32 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 16, 26, and 27 as obvious based on the combination of U.S. Patent No. 4,924,279 to Shimbo and U.S. Patent No. 7,138,682 to Kamata. The Official Action further rejects claim 17 as obvious based on the combination of Shimbo, Kamata, and U.S. Patent No. 4,547,789 to Cannella. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

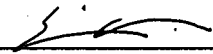
teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach, either explicitly or inherently, or suggest all the features of the independent claim 16, as amended. Independent claim 16 has been amended to recite a feature of "forming a semiconductor film by using a metal mask in a vapor deposition device at least over the exposed side surface." This feature is supported by at least page 23, lines 24-28 of the specification. It is respectfully asserted that neither Shimbo nor Kamata disclose or suggest this feature. Therefore, since the prior art relied upon in the Official Action fails to disclose or suggest each and every feature recited in the claims, it is respectfully submitted that a *prima facie* case of obviousness cannot be maintained. Favorable reconsideration is requested.

New claims 28-35 have been added to recite additional protection to which the Applicant is entitled. The features of independent claim 28 are supported by at least Figure 1B and the features of independent claim 32 are supported by at least Figure 2B, for example. These claims are believed to be allowable for at least the same reasons as noted above.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789